



Docket No 196838US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Frank I. CARROLL, et al.

SERIAL NO: 09/623,872

GAU: 1625

FILED: October 17, 2000

EXAMINER: C. AULAKH

FOR: NOVEL OPIATE COMPOUNDS, METHODS OF MAKING AND METHODS OF USE

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

- ☒ The applicant(s) wish to make of record the references listed on the attached form PTO-1449 w/copy of European Office Action. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references. A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- ☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

- ☐ Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- ☒ Please charge any additional fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

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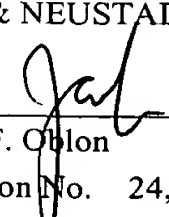
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Respectfully submitted,

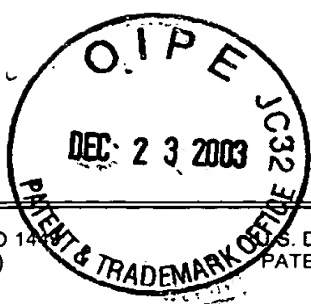
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Form PTO 1449
(Modified)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY DOCKET NO.

196838US0PCT

SERIAL NO.

09/623,872

LIST OF REFERENCES CITED BY APPLICANT

APPLICANT

Frank I. CARROLL, et al.

FILING DATE

October 17, 2000

GROUP

1625

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	AA	6,436,959	08/20/02	CARSON ET AL			
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						
	AM						
	AN						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AO					
	AP					
	AQ					
	AR					
	AS					
	AT					
	AU					
	AV					

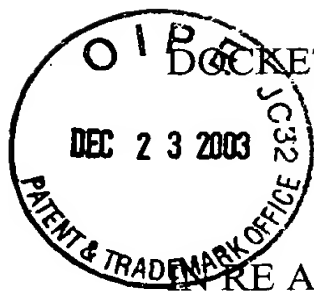
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

	AW	Provisional Application Serial No. 60/068,794, filed December 24, 1997.				
	AX					
	AY					
	AZ					<input type="checkbox"/> Additional References sheet(s) attached

Examiner

Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RE APPLICATION OF

FRANK I. CARROLL, ET AL.

SERIAL NO: 09/623,872

FILED: OCTOBER 17, 2000

FOR: NOVEL OPIATE COMPOUNDS, METHODS OF MAKING AND METHODS OF USE

:

:EXAMINER: C. AULAKH

:

: GROUP ART UNIT: 1625

COMMENTS ON INFORMATION DISCLOSURE STATEMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In the Information Disclosure Statement (IDS) submitted herewith, U.S. patent No. 6,436,959 (the '959 patent) and U.S. provisional application serial No. 60/068,794 (the '794 application) are cited. Also included is an official communication dated August 28, 2003 in the corresponding European application.

The communication discusses Document D2, WO 99/33806A (WO '806; of record) at page 2. The European examiner states that compounds P73 and P81 of WO '806 are identical to compounds 3a/b of the present application. The European examiner also states that compounds P73 and P81 are also contained in the priority document of WO '806, which is the '794 application.

The '959 patent appears to be part of the same patent family as WO '806. The '959 patent issued after the effective filing date of the present application. However, according to paragraph 21 on the cover page, the patent issued from application serial No. 09/220,189 (the '189 application), which was filed on December 23, 1998. Since December 23, 1998 is prior

Application No. 09/623,872

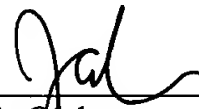
to the March 9, 1999 international filing date of the present application, the '189 application appears to be available, date-wise, under 35 U.S.C. §102(e) against the present application.

According to the cover page, the '959 patent does not claim benefit of the filing date of the '794 application. Based on that fact, the '794 application does not appear to be available against the present application.

Consideration of the IDS submitted herewith is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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Patentamt

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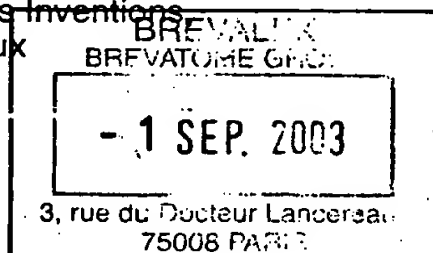
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Application No. 99 912 345.8 - 2101	Ref. SR 18743 US/PA	Date 26.08.2003
Applicant RESEARCH TRIANGLE INSTITUTE		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



KOLLMANNSSBERGER M
Primary Examiner
for the Examining Division

Enclosure(s): 2 page/s reasons (Form 2906)



The examination is being carried out on the **following application documents** :

Description, Pages

1-137 as originally filed

Claims, Numbers

1-26 as originally filed

Drawings, Sheets

1/19-19/19 as originally filed

1. Although the examining division has not received a new set of claims it is assumed that the parts relating to inventions 1-3 have been deleted as indicated in your letter of 21 may 2003. The examination thus covers original claims 17-22 and 26. For other parts divisional applications would have to be filed if the applicants wants to maintain them (cf. previous communication, last paragraph).
2. The present claims are **not** entitled to the claimed priority of march 10, 1998 (Art. 87-89 EPC). The priority document does not appear to contain a generic structure which would correspond to the generic structures of any of claims 17-22 . The examining division could in fact not identify any generic structure in the priority document which could be seen as a basis for a priority claim of one of the generic structures present in the description of the application (e. g. in the priority document on page 7 substituent definitions are missing as well as on page 52). It appears that the priority could only be validly claimed for the example compounds 3a/3b of the description since these are specifically disclosed in the priority documents (see page 108).
3. The following documents are considered relevant:

D1: WO 98 28270 A
D2: WO 99 33806 A



Datum
Date 26.08.2003
Date

Blatt
Sheet 2
Feuille

Anmelde-Nr.:
Application No.: 99 912 345.8
Demande n°:

D1 was cited in the international search report, D2 in the supplementary european search report.

4. Since the priority of the claims is not valid, D1 (published 2 July 1998) forms state of the art according to Art. 54(2) EPC. D2 has entered the regional phase (application number 98964871.2) and the relevant fees have been paid. The requirements of Article 158(2) EPC are thus fulfilled. Since it was filed before the filing date of the present application, its content forms state of the art according to to Article 54(3) and (4) EPC for parts not entitled to the claimed priority (i. e. the present claims).
5. D1 discloses generic structures (see e. g. claim 3) as well as example compounds (see e. g. examples 2, 5, 9, 10 etc) all included in the scope of present claims 17-22. Since the use is the same also claim 26 is not novel.

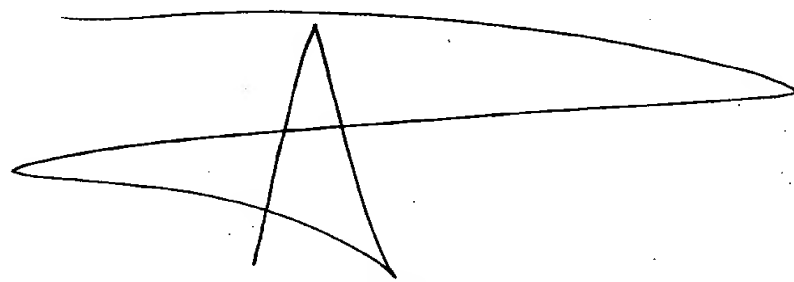
D2 discloses compounds (see generic formula on page 8 and examples in the tables 9-13) which are all included in claims 17-22. Additionally, the compounds P73 and P81 on page 11 in D2 are identical to the only example compounds 3a/b of the present description. Since these two individual compounds are also contained in the priority document of D2 (P73 and p81 on page 29 of the priority document of D2) and the priority date of D2 lies before the priority date of the present application, even a claim directed to the two example compounds (which would enjoy the claimed priority) would not be novel under Art. 54(3).

6. It is not apparent which part of the application could serve as a basis for a new, allowable claim in view of D1 and D2. A refusal of the application under Article 97(1) EPC for lack of novelty (Art. 54 (2)-(4)) is therefore to be expected.

5. In item 5 the examiner also considers that claims 17 to 22 are not novel in the light of D2 (said document is cited under article 54(3) EPC and is therefore relevant only for novelty of claims), this objection appears to be quite well founded.
6. Thus, even if we could overcome the objection relating to the priority, document D2 will still remain relevant.
7. Could you please provide us with your instruction before December 15, 2003 ? An extension of time by two months (without fee) is available.

Should you wish to file divisional applications related to the other inventions (groups 1 to 3) said applications should be filed when the present application is still pending (i. e. before any withdrawal).

Very truly yours,

A handwritten signature in dark ink, consisting of a stylized, elongated shape with a central vertical stroke and a horizontal crossbar, resembling a large, thin 'A' or a signature flourish.

Philippe AUDIER